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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,291	08/04/2006	Yit-Shun Leung Ki	2590-161	8675
23117 7590 12/09/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
GEORGE, PATRICIA ANN				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
12/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/588,291

Applicant(s)

LEUNG KI, YIT-SHUN

Examiner

Patricia A. George

Art Unit

1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794

/Patricia A George/
Examiner, Art Unit 1794

Continuation of 11. does NOT place the application in condition for allowance because: The claims applicant requested be considered are not the claims of record. Applicant's amendments and remarks have been considered, but are not deemed persuasive over the prior art of record, which rejections were and are maintained for the reasons of record.

Continuation of 13. Other:

Continuation of 13. Other:

Applicants remark, on page 2, that there is an agreement to abandon claim 1, and claims 3-5. No such amendment has been submitted for the record. On the same topic, applicants discuss in the conclusion section proposed new claims 1 and 6. Such remarks are not consistent with the proper format for amending claims, as on a separate sheet of paper, as in MPEP 37 CFR 1.121. For the sake of examination, and response to the remarks, submitted 11/18/2008, claims 1, and 6-20 are pending as in the last amendment of record, on 5/16/2008. Further, any amendment to claim 1 would not be considered "new" as stated, but denoted as "Currently Amended."

On page 4, applicants remark that the cross-seeding of an essentially academic machining method onto a highly industrial application is the heart of the invention, however, these limitations are not commensurate with the scope of the claimed language.

Applicants present three arguments A, B, and C which have all been considered, however none of the three are persuasive in overcoming Leech in view of the combination of Drinkwater, Gealer, and Olds, as applied in the office action of 8/18/2008.

Argument A asserts that Leech fails to teach "transitory reflective mode structures". This argument is not commensurate with the scope of the claimed language.

Argument B asserts that the method as disclosed by applicants has not been invented by the many skilled in the art. Had applicants claimed invention been disclosed by one of skill in the art, it would have been rejected under 35 USC 102 as being anticipated. The rejection as presented in the office action of 8/18/2008 is a 35 USC 103 rejection, which is based on obviousness. Applicants assertion that Lee does not teach wet etching of silicon, however Lee is not relied on in the rejection as presented.

Argument C asserts that the relief is not provided on a flattened paper, metal or polymer substrate as in the method of claim 20, however this negative limitation is not commensurate with the scope of the claimed language.

Applicant appears to repeatedly assert that the references as applied are not analogous art, and specifically presents, on page 2, different reasons for motivation for the claimed invention. These arguments have been fully considered and are not persuasive because:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for the rejection is found, either in the references, or in the knowledge generally available to one of ordinary skill in the art. See MPEP 7.37.04 Unpersuasive Argument: No Suggestion To Combine

In response to applicant's argument that the references provided are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the art as applied is pertinent to the problem of using a shim to replicate a pattern. See MPEP 7.37.05 Unpersuasive Argument: Nonanalogous Art.